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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/651,170	08/30/2000	Robert Eric Montgomery	12080-4	2711
7590	03/07/2003			
John L. Reed BriteSmile, Inc. 490 North Wiget Lane Walnut Creek, CA 94598			EXAMINER ROSE, SHEP K	
		ART UNIT 1614	PAPER NUMBER <i>16</i>	
DATE MAILED: 03/07/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	09/965170	Applicant(s)	MONTOO MORY, et al
Examiner	S. W. ROSE	Group Art Unit	1614

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- Responsive to communication(s) filed on RCF REQUEST PENDING C OCT, 28 2002.
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- Claim(s) 25283 6 17 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) \_\_\_\_\_ is/are rejected.
- Claim(s) 25283 6 17 is/are objected to.
- Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved.  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  Interview Summary, PTO-413
- Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

### Office Action Summary

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The reply filed on October 28, 2002 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): an RCE request was filed on Oct. 28.2002, an RCE must be directed to the same subject matter, and same inventions as was presented in the claims of the parent, whose examination on their merits, has been constructively elected by original presentation.

Although original claims 6 and 14 have not been cancelled they are both dependent on the cancelled peroxyacid precursor of cancelled claim 4, or cancelled claim 13 and newly presented claims 25 to 43 are clearly improperly directed to subject matter never presented and hence never examined in the parent. Note that newly presented claims 27, 28, 34, 35, 41, 42 not only find no basis in any parent case claim, as required of an RCE (page 3, lines 15 to 24 teaches avoidance of encompassed glycerin, propylene glycol and polyethylene glycol species of polyhydroxy compounds as causing tooth sensitively), and the enablement for these polyol species as set forth on page 12, lines 21 to 25, improperly incorporates by reference EP 443.651 (copy requested) MPEP 608.01 (P)(C) requires, U.S. patents for such background information.

None of claims 25 to 43 provide antecedent basis for uncancelled original claims 6(as noted above) which is not hydrogen peroxide, or for claim 14, which is dependent on cancelled claim 13, to titanium or zinc oxides, nanometer sized semiconductor particles. An RCE can only proceed on claims 6 and 14 as independent claims, and only as based on the fact that they were originally presented and examined on their merits.

The disclosure is objected to under 37 CFR 1.71, as being so incomprehensible as to preclude a reasonable search of the prior art by the examiner. For example, the following items are not understood: as noted above, hydrogen peroxide and the subject matter of claims 27, 28, 34, 35, 41 and 42. Where is it?

Applicant is required to submit an amendment which clarifies the disclosure so that the examiner may make a proper comparison of the invention with the prior art. Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

A shortened statutory period for reply to this action is set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter.

See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shep Rose whose telephone number is (703) 308-4609. The examiner can normally be reached on Monday, Tuesday, and Thursday 7:30am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

Art Unit: 1614

305-4544 for regular communications and (703) 305-3592 for After Final  
communications.

Any inquiry of a general nature or relating to the status of this application or  
proceeding should be directed to the receptionist whose telephone number is (703) 308-  
1235.



SHEP K. ROSE  
PRIMARY EXAMINER

Rose/tgd  
March 5, 2003